

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-32 and 34-47 remain in this application. Claim 33 has been canceled. Claims 48 and 49 have been added.

Claims 1-4, 10-15, and 29-32 and 34-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fraccaroli (U.S. Pat. App. 2004/0002348) in view of Will (U.S. 6,721,410). The remaining claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Fraccaroli and will, or in view of various other additional cited references. For the following reasons, the rejections are respectfully traversed.

Claim 1 has been amended to recite a method for finding members of a common interest group with a mobile device with the method including the step of:

said mobile device generating a graphical image of the another of said members, said image generated from said graphical image information for display to the one of said members for enabling the visual identification of the another of said members by the one of said members when the one of said members has never seen the another of said members...

Claim 40 recites similar limitations. Claim 41 recites a method for finding members of a common interest group with a mobile device including the steps of:

sending a message including said graphic image information for one of said members to at least another of said members if he is in the vicinity of the another of said members of the common interest group [and]

using said graphic image information to generate a graphic image on said mobile device...

Similarly, new claim 51 recites a method for finding members of a common interest group including the steps of:

providing a database for storing a plurality of digital photographs, wherein each of said photographs corresponds to a different one of the members...

sending the digital photograph corresponding to the one of said members to the mobile device of the another of said members when it is determined that the one of said members is in the vicinity of the another of said members, and

said mobile device of the one of said members displaying said photograph of the another of said members for enabling the visual identification of the another of said members by the one of said members.

None of the cited references teach any such generation of a graphical image or photograph on a mobile device in the manner required by the various claim language.

The Examiner attempts to cite Will as teaching showing a graphical image on a computer. However, the computer of Will is not a mobile device. Thus, the Examiner has not shown any mobile device capable of displaying such an image or photograph, and thus claims 1, 40, 41, and 51, along with the claims dependent thereon, are patentable over the references.

Furthermore, it is well-known that the graphical display capability of a stationary computer is typically much greater than the display capability of a mobile device. Thus, modifying Fraccaroli with the capability of Will would be beyond the ability of one skilled in the art, and would not necessarily lead to a usable device. Furthermore, such a modification would change the principle of operation of the Fraccaroli device, which nowhere suggests the ability to show graphical images of sufficient resolution to enable visual recognition of a person never seen before, as required by the claim.

The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

Furthermore, the proposed modifications cannot render the prior art unsatisfactory for its intended purpose, or change the principle of operation of a reference (MPEP §2143.01). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125

Thus, the proposed modification is not permissible, and thus the Examiner has failed to provide a prima facie case of obviousness, and thus the rejections for obviousness must be withdrawn.

Claim 42 recites a method for finding members of a common interest group with a mobile device with the method including the steps of:

storing a predetermined message criterion different from membership in said common interest group for determining when a message is sent to one of said members; and

sending said message to the one of said members if he is in the vicinity of another of said members and only if said message criterion is satisfied...

The Examiner has failed to show any such message criterion as recited in the claim, and applicant could find no such criterion, and thus this claim is patentable over the references, as are claims 43-47, which depend on claim 42.

New claim 52 recites a method for finding members of a common interest group including the step of:

the one of said members getting into direct contact with the another of said members by using the displayed identifying information for identifying the another of said members

None of the references teach any such "direct contact" and thus the claim is patentable over the references for at least that reason.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33835.

Respectfully submitted,

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